

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Aaron Weinberg Allowed: July 31, 2009
Application Number: 10/538,811 Art Unit: 1645
Filed: March 09, 2006 Examiner: Tongue, Lakia J.
For: DEFENSIN-INDUCING AGENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
37 C.F.R. § 1.705(d)

1. This request is for reconsideration of the patent term adjustment indicated on page 3 of the Notice of Allowance.
2. Applicant submits herewith a "Statement of the Facts Involved in Determining the Patent Term Adjustment" 37 C.F.R. § 1.705(b)(2).
3. This patent is not subject to a terminal disclaimer. 37 C.F.R. § 1.705(b)(2)(iii).
4. The fee set forth in § 1.18(e) (\$200.00), required by 37 C.F.R. § 1.705(b)(1), is paid as follows:

Please charge any fees required by this paper to Deposit Account No. 15-0450.

Date: August 27, 2009

/John J. Cunniff/
Signature of Practitioner

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Attached hereto is:

"STATEMENT OF THE FACTS INVOLVED IN DETERMINING THE PATENT TERM ADJUSTMENT" 37 C.F.R. § 1.705(b)(2).

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STATEMENT OF THE FACTS INVOLVED IN DETERMINING
THE PATENT TERM ADJUSTMENT
37 C.F.R. § 1.705(b)(2)

1. This statement is being submitted in support of the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT 37 C.F.R. § 1.705(d)” to which this statement is attached.
2. The patent term adjustment shown on page 3 of the Notice of Allowance is three hundred eighty-two (382) days.

A four hundred fifteen (415) day delay was charged against the USPTO and a thirty-three (33) day delay was charged against the Applicant.

Applicant asserts that it is not correct to charge 415 days against the USPTO, and that instead, Applicant asserts that five hundred fifty-nine (559) days should be charged against the USPTO. Applicant also asserts that it is correct to charge 33 days against the Applicant.

37 C.F.R. § 1.705(b)(2)(i) and (ii)

It is respectfully suggested that the correct patent term adjustment under § 1.702(a)(1) and § 1.702(b) is five hundred twenty-six (526) days. 37 C.F.R. § 1.702(a)(1) states that the term shall be adjusted if the Office fails to “[m]ail at least one of a notification under 35 U.S.C. 132... not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a)...” 37 C.F.R. § 1.702(b) states that the term shall be adjusted if the Office fails to:

issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including: (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b); (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a); (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181; (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or (5) Any delay in the processing of the application by the Office that was requested by the Applicant.

Basis, including relevant dates as specified in 37 C.F.R. § 1.703(a)(1):

The filing date was March 09, 2006 under 35 U.S.C. 111(a), and the ending date of a mailing of an action under 35 U.S.C. 132 was June 27, 2008. Based on these dates, the number of days between them is four hundred fifteen (415) days.

Basis, including relevant dates as specified in 37 C.F.R. § 1.703(b):

The date, which begins three years after the filing, was March 09, 2009, and the ending date was July 31, 2009. Therefore, based on these dates, the period of adjustment under 37 C.F.R. § 1.702(b) should be one hundred forty-four (144) days.

Furthermore, the correct days charged against the USPTO should be the summation of the days specified in 37 C.F.R. § 1.703(a)(1), 37 C.F.R. § 1.703(a)(2) and 37 C.F.R. § 1.703(b). The USPTO may view these days as “overlapping” under 35 U.S.C. § 154(b)(2)(A), however, according to *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063, the Court concluded that “the only way that periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another, they do not overlap, and § 154(b)(2)(A) does not limit the extension to one day.” The Court reasoned that:

[t]he problem with the PTO's construction is that it considers the application *delayed* under § 154(b)(1)(B) during the period *before it has been delayed*. That construction cannot be squared with the language of § 154(b)(1)(B), which applies "if the issue of an original patent is *delayed* due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years." (Emphasis added.) "B delay" begins when the PTO has failed to issue a patent within three years, not before.

Therefore, since the days calculated under 37 C.F.R. § 1.703(a)(1) and 37 C.F.R. § 1.703(b) do not overlap, it is Applicant's position that the correct days charged against the USPTO under § 1.702(a)(1), and §1.702(b) is five hundred fifty-nine (559) days.

37 C.F.R. § 1.705(b)(2)(iii)

4. This patent is not subject to a terminal disclaimer.

Respectfully submitted,

Date: August 27, 2009

/John J. Cunniff/
Signature of Practitioner

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